

Applicants : Charles C. Willis et al
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REMARKS

Applicants respectfully request reconsideration of the above-identified patent application. Claims 1-15 are pending; claims 16-20 are withdrawn; and claims 1, 2, 4, 7, 9-11, 13 and 15 are amended. Applicants respectfully traverse the rejections as conceivably applied to the amended claims.

I. Election

Applicants acknowledge the Examiner's withdrawal of claims 16-20.

II. Allowable Subject Matter

Applicants thank Examiner Stashick for the statement that claims 7-8, 13 and 15 would be allowable if rewritten in independent form. Applicants have rewritten these claims, and submit that claims 7-8, 13 and 15 are now fully allowable.

III. Prior Art Rejections

As originally presented, claims 1-6, 9-13 and 14 were rejected under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent 6,594,922 to Mansfield in view of either 6,286,232 to Snyder or 6,481,120 to Xia.

Mansfield discloses footwear including an upper, a midsole and an outsole. As shown in Figs. 5 and 6, the Mansfield upper 40 is secured to an interior 34; and the interior 34 is secured to a midsole 32. As noted by the Examiner, the upper 40 includes "a lower portion (that located just above the interior 34)." Office Action, Pg. 2. An outsole 30 is secured to the midsole 32 opposite the interior 34 and/or foot stabilizer 2.

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Snyder and Xia disclose sizing lines to instruct a consumer in cutting an insole to various sizes (*see* lines 22a-22d in Fig. 3 of Xia, and the dotted lines in Fig. 3 of Snyder). These sizing lines are always visible to ensure that a consumer can cut the respective insoles to fit whatever sized shoe into which the insoles are to be inserted.

Applicants respectfully submit that: (1) there is no motivation or suggestion to modify and/or combine Mansfield with either of Snyder and/or Xia to arrive at the present invention; and (2) even if combined, Mansfield and Snyder or Xia fail to disclose, teach or suggest all the subject matter of the amended claims.

First, the Examiner asserts that Mansfield does not disclose a trim line on the bottom of the midsole, but that it would have been obvious “to place trim lines, such as those taught by Snyder et al. ‘232 and Xia et al. ‘120, on the top and bottom surface of the midsole of Mansfield et al. ‘922 *to sho[w] the manufacturer where to trim the midsole for the size shoe being fitted to.*” Office Action, Pg. 4 (Emphasis supplied). Applicants submit that this is incorrect, and that there is no motivation or suggestion to combine the references for any reason, let alone for the reasons italicized above. Specifically, the amended claims now recite that the trim lines are coincident with a former flashing location or a mold flashing location on the bottom surface of a midsole. As noted in the present application (Pgph. 0023), this trim line corresponds to removed excess material formed at the seams of the molds used to make the midsole when the midsole is direct attached to the upper. There would be no reason to “trim the midsole for the size shoe being fitted to” as proposed by the Examiner because the manufacturing molds are already designed for unique upper sizes of the

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construction. Manufacturers would *not* trim the midsole of Mansfield as proposed to a specific size—to do so would waste the trimmed material and add needless cost to manufacture the footwear. Instead, the Mansfield midsole would be created in the proper size when first molded. Moreover, the sizing lines of Snyder and Xia are clearly used by end users (i.e., purchasers of aftermarket insoles) to guide those consumers in retrofitting their existing footwear—not by manufacturers. Accordingly, Applicants submit there is no motivation to modify Mansfield itself, or with Snyder or Xia, to arrive at the claimed invention.

Second, even if combined, Mansfield in view of Snyder or Xia fail to disclose, teach or suggest: (1) a bottom surface trim line coinciding with a former flashing location (claim 1) or coincident with a mold flashing location (claim 10) on the bottom surface; or (2) an upper surface direct attached to the lower portion of said upper (claim 1) or the upper (claim 10). Instead, the sizing lines of Xia and Snyder are intentionally and directly formed on the respective surfaces of the insoles; and no flashing was ever associated with the location of those sizing lines. Further, Applicants have carefully reviewed the Mansfield citation in the Office Action, namely, Col. 9, Lns. 20-42, and have found no support for the position that the midsole upper surface is direct attached to the lower portion of the upper. The citation confirms that the interior 34 is a *separate component* from the upper 40, and that the “interior 34 [is] positioned on top of midsole 32, an upper 40 [is] positioned on top of, and connected to the perimeter of interior 34.” Col. 9, Lns. 26-30. If anything, Mansfield makes it clear that the midsole is *separated from* the upper by the interior 34 and therefore *not* attached to the upper as recited in the amended claims.

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Accordingly, it is respectfully submitted that the pending claims are patentable, and that the §103 rejections are improper and should be withdrawn.

Further, the dependent claims recite additionally patentable subject matter, and are therefore allowable for the reasons set forth above in connection with the amended independent claims.

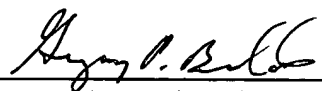
CONCLUSION

In view of the above amendments and Remarks, Applicants respectfully submit that the present application is in condition for allowance. A notice to that effect is earnestly and respectfully requested. If the examiner believes that it would be helpful to resolve any outstanding issues, he is invited to contact the undersigned.

Respectfully submitted,

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